

REMARKS

Summary of Amendments

Applicants have canceled claims 2 and 3 and amended claim 1 to more particularly define the present invention. As amended, claims 1 and 4-6 remain pending in the present application. Applicants have also amended the specification to correct the informalities therein. No new matter has been added. Given the foregoing amendments and the following discussions, all objections and rejections are overcome and withdrawal thereof is respectfully requested.

Objections to the Specification

The Examiner has objected to the specification for various informalities. Applicants have amended the abstract, added section headings, amended to the title of the invention and corrected the informalities in paragraphs [0002] and [0007] as required by the Examiner.

Claim Rejections Under 35 U.S.C. §112

The Examiner rejected claim 1 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended claim 1 to more particularly define the present invention and amended the term “the durability” to “the durability of said security sheet”.

Claim Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1 and 4 under 35 U.S.C. §102(b) as being anticipated by Shenton (US 5,199,744).

Shenton teaches a method of providing a security device on a substrate comprising embossing at least one transitory image, and a linear area which is visible when the device is examined from substantially all viewing angles. Shenton further teaches that the substrate printed with metallic inks could be overprinted with a tinting lacquer to provide colored metallic effects. The Examiner contends that the lacquer inherently imparts increased durability relative to the uncoated printed surface.

The present invention as defined in claim 1, as amended, relates to a method for finishing a printed security sheet carrying at least one distinguishing feature, comprising: (1) partially coating the printed security sheet in one step with a layer of lacquer to the at least one distinguishing feature such that the at least one distinguishing feature is emphasized by increasing the transparency thereof; and (2) coating the printed security sheet in another step over its whole surface to increase the durability of the security sheet. Claim 4 further defines the distinguishing feature as a security feature.

A claim can be rejected under 35 U.S.C. §102 only if each element of the claim is disclosed in a single prior art reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Shenton fails to teach or suggest a two-step method as required in the present claims 1 and 4, much less the distinct features of the two steps, first, partially coating the distinguishing feature to increase the transparency of the distinguishing feature, and second, coating the whole

surface of the security sheet to increase the durability of the security sheet. Therefore, the present invention as defined in claims 1 and 4 is novel over Shenton.

The Examiner rejected claims 1, 2 and 4-6 under 35 U.S.C. §102(b) as being anticipated by Weitzberg et al. (US 3,533,176). Claim 2 has been canceled. The rejection thereto is moot.

Weitzberg et al. teaches a tamper-proof identification document comprising a base card to one side of which there is inseparably attached a photographic layer comprising both a picture section and a data text section. The photographic layer must be secured by a transparent security coating or protective layer which inseparably adheres to the photographic layer. The Examiner contends that the transparent/clear lacquer would inherently emphasize/optically accentuate underlying features.

Weitzberg et al. fails to teach or suggest a two-step method as required in the present claims 1 and 4-6, and much less the distinct features of the two steps: (1) partially coating the distinguishing feature to emphasize the distinguishing feature by increasing the transparency thereof; and (2) coating the whole surface of the security sheet to increase the durability of the security sheet. Therefore, the present invention as defined in claims 1 and 4-6 is novel over Weitzberg et al..

The Examiner rejected claims 1-5 under 35 U.S.C. §102(b) as being anticipated by Haghiri et al. (US 5,888,624). Claims 2 and 3 have been canceled. The rejections thereto are moot.

Haghiri et al. teaches IC cards, for example telephone cards, comprising a one- or multilayer card body in which an electronic module is embedded. The layers of the card body consist of paper and/or cardboard and are interconnected by thermal activable adhesive or contact adhesive. The individual card layers are provided with the necessary windows for

receiving the electronic modules and finally interconnected. Haghiri et al. further teaches that to protect the edge of the card from splitting, a special protecting lacquer can be applied to the edge of the card (column 9, lines 16-18). In the finished card the external surfaces of the cover layers can be protected by a thin layer of lacquer, for example, in the form of gloss lacquer (column 9, lines 44-50). Individual layers can additionally be provided with security elements, such as watermarks (column 9, lines 51-54).

Although Haghiri et al. teaches two types of lacquering, they are different from the two steps of coating of the present invention as defined in claims 1, 4 and 5. Haghiri et al. teaches (1) providing a protecting lacquer to the edge of the multilayer IC card to protect the edge from splitting; and (2) providing a layer of lacquer to the cover layers to provide gloss to the cover layers of the IC card. These two coatings are different from the two steps of the claimed method of the present application: (1) partially coating the distinguishing feature to emphasize the distinguishing feature by increasing the transparency thereof; and (2) coating the whole surface of the security sheet to increase the durability of the security sheet. The claimed invention is significantly different from the teachings of Haghiri et al. in the area to be coated and in the purpose and effect of the coating. Haghiri et al. does not teach or suggest coating the distinguishing feature, for example watermarks, to emphasize the distinguishing feature by increasing the transparency thereof. Therefore, the present invention as defined in claims 1, 4 and 5 is novel over Haghiri et al..

Based on the above remarks, Applicant respectfully submits that the claimed invention is novel over the applied prior art. Accordingly, the rejections to claims 1 and 4-6 under 35 under 35 U.S.C. §102(b) are overcome and withdrawal thereof is respectfully requested.

Claim Rejection Under 35 U.S.C. §103

The Examiner rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over Haghiri et al. (US 5,888,624) in view of Weitzberg et al. (US 3,533,176).

As discussed above, Haghiri et al. teaches (1) providing a protecting lacquer to the edge of the multilayer IC card to protect the edge from splitting; and (2) providing a layer of lacquer to the cover layers to provide gloss to the cover layers of the IC card. These two coatings are different from the two steps of the claimed method of the present application: (1) partially coating the distinguishing feature to emphasize the distinguishing feature by increasing the transparency thereof; and (2) coating the whole surface of the security sheet to increase the durability of the security sheet. The claimed invention is significantly different from the teachings of Haghiri et al. in the area to be coated and in the purpose and effect of the coating. Haghiri et al. does not teach or suggest coating the distinguishing feature, for example watermarks, to emphasize the distinguishing feature by increasing the transparency thereof.

Weitzberg et al. teaches an identification document comprising a base card to one side of which there is inseparably attached a photographic layer. The photographic layer must be secured by a transparent security coating or protective layer which inseparably adheres to the photographic layer. Weitzberg et al. fails to teach or suggest a two-step method as required in the present claims 1, 4 and 5, much less the distinct features of the two steps, first, partially coating the distinguishing feature to emphasize the distinguishing feature by increasing the transparency thereof, and second, coating the whole surface of the security sheet to increase the durability of the security sheet.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure in the specification. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the combination of Haghiri et al. and Weitzberg et al. (whether or not they can be combined) still fails to teach or suggest all the limitations of the present invention as defined in claims 1, 4 and 5: (1) partially coating the distinguishing feature to emphasize the distinguishing feature by increasing the transparency thereof; and (2) coating the whole surface of the security sheet to increase the durability of the security sheet. Therefore, the claimed invention is not obvious over Haghiri et al. (US 5,888,624) in view of Weitzberg et al. (US 3,533,176). The rejection under 35 U.S.C. §103(a) are overcome and withdrawal thereof is respectfully requested.

The Examiner rejected claim 3 under 35 U.S.C. §103(a) as being unpatentable over Weitzberg et al. (US 3,533,176) in view of Haghiri et al. (US 5,888,624). Applicants have canceled claim 3. The rejection thereto is moot.

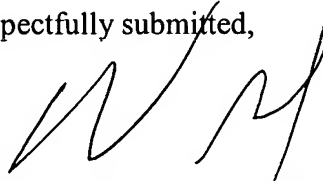
Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is

respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees to Goodwin Procter LLP Deposit Account 06-0923.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. Samuel', written over a horizontal line.

Richard I. Samuel (Reg. No. 24,435)
GOODWIN PROCTER LLP
7 Becker Farm Road
Roseland, NJ 07068
(973) 992-1990

MARKED-UP VERSION OF WRITTEN PARAGRAPHS

[0002] The invention relates to a process for finishing printed [[securities]] security sheets.

[0007] Pursuant to the invention, this objective is accomplished by [the distinguishing feature or features of the first claim]providing a method for finishing a printed security sheet carrying at least one distinguishing feature. The method comprises partially coating the printed security sheet in one step with a layer of lacquer to the at least one distinguishing feature such that the at least one distinguishing feature is emphasized by increasing the transparency thereof; and coating the printed security sheet in another step over its whole surface to increase the durability of the security sheet.

ABSTRACT

[The invention relates to a]A method for finishing printed security [paper] sheets to improve the recognition of security features. [The printed security paper sheets may be partly or entirely covered with a lacquer used for increasing the durability of printed security paper sheets and for enhancing the security features.]The method comprises partially coating the printed security sheets in one step with a layer of lacquer to the distinguishing features on the printed security sheets to increase the transparency thereof such that the distinguishing features are emphasized; and coating the printed security sheets in another step over the whole surface thereof to increase the durability of the security sheets.

MARKED-UP VERSION OF REWRITTEN CLAIM

1. (Twice amended) A method for finishing a printed security sheet, [wherein printed security sheets are lacquered completely and/or partly in order to increase the durability and to emphasize distinguishing features] said printed security sheet comprising at least one distinguishing feature, said method comprising:
 - partially coating said printed security sheet in one step with a layer of lacquer to said at least one distinguishing feature, whereby said at least one distinguishing feature is emphasized by increasing the transparency thereof; and
 - coating said printed security sheet in another step over its whole surface to increase the durability of said security sheet.